

R E M A R K S

Claims 1 - 5 are pending.

Claim 1 is the only independent claim.

Claim Amendments

Independent claim 1 has been amended solely to recite a desired embodiment.

Section 101 Rejections

Claims 1 - 5 have been rejected as nonstatutory. Applicants traverse this rejection since there has been no prima facie showing that any claim is nonstatutory.

The Examiner contends that claims 1 - 5 are per se non-statutory because they are directed to "a method of producing a disembodied data structure". However, this analysis is essentially reversed.

The test for statutory subject matter is that the claims produce a useful, concrete and tangible result. In other words, the inquiry must focus on whether the claims produce a useful, concrete and tangible result, not on whether the claims produce "a disembodied data structure". Instead, the Examiner has *assumed* that since the claims produce "a disembodied data structure", they must fail to produce a useful, concrete and tangible result.

Since the Examiner has failed to demonstrate that the claims fail to produce a useful, concrete and tangible result, and since each does in fact produce a useful, concrete and tangible result (as described in the specification), there has been no prima facie showing that the claims are nonstatutory.

Further, the claims are rejected "for failing to fall within the technological arts". Since there is no technological arts requirement, this rejection is improper. See, e.g., Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005).

Obvious-type Double Patenting Rejection

Claims 1 - 5 are rejected as unpatentable over claims 1 - 12 of U.S. Patent No. 6,267,670. Applicants traverse this rejection since there has been no prima facie showing that any pending claim is rendered obvious by any or all of claims 1 - 12 of U.S. Patent No. 6,267,670.

The only reasoning provided for this rejection is on page 5 of the Office Action:

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same essential subject matter.

Clearly, this fails to present a prima facie case of double patenting since there is no obviousness analysis of any pending claim.

Applicable Law

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v. John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1).

The factual inquiries that must be made are:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

See MPEP 804(II)(B)(1).

When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

One-way test was not applied

The patent used in the double patenting rejection was not filed after the filing date of the present application. Therefore, the "one-way test" is required. MPEP 804(II)(B)(1)(a).

This test is a determinant of whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. MPEP 804(II)(B)(1)(a).

However, here the Examiner has asserted that only that the pending and issued claims "are drawn to the same essential subject matter".

Claim Limitations Ignored

In addition, in determining the obviousness of a claim, all claim limitations must be considered. Each of the pending claims has been rejected in one sentence double patenting rejections. Each of these rejections ignores several claims limitations of the claims. For example, all pending claims include the following limitation:

allocating a portion of a ticket, the portion being based on the monetary value

Claims 1 - 12 of U.S. Patent No. 6,267,670 do not include such a limitation, and the Examiner has not provided any sort of obviousness analysis regarding this limitation and in particular how claims 1 - 12 of U.S. Patent No. 6,267,670 would, by themselves, render obvious any pending claim.

No motivation to Modify

No motivation to modify the patent is indicated. There is only the conclusory statement that the issued claims are essentially the same subject matter as the pending claims. The motivation must be a specific teaching or suggestion in the prior art to combine or modify the references of record.

Section 103 Rejections

Claims 1 - 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of Nilssen (US 5,083,784) and Burke (US 6,112,191). Applicants traverse this rejection since there has been no prima facie showing that any pending claim is rendered obvious by the references of record, either alone or in combination.

All pending claims include the following limitation:

allocating a portion of a ticket, the portion being based on the monetary value

Contrary to the Examiner's assertion, Nilssen neither discloses nor suggests such a limitation. Conspicuously, there is no reference in the rejection to any portion of Nilssen, which essentially is directed to a lottery system wherein a lottery ticket, once purchased, continues on ongoing periodic basis to provide chances for winning a large prize. In Nilssen there are no *portions of a ticket*, much less that portions are in any way *based on a monetary value*.

Conclusion

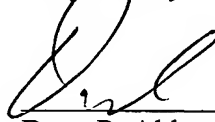
The Examiner's early examination and consideration are respectfully requested. Alternatively, if there are any questions regarding the present application, the Examiner is invited to contact Applicants' undersigned attorney using the information provided below.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Dean P. Alderucci at telephone number (203) 461-7337 or via electronic mail at Alderucci@walkerdigital.com.

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Date

Respectfully submitted,



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